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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/808,423	03/14/2001	Gene E. Nacey	569.005	3458
35195	7590	03/06/2006	EXAMINER	
FERENCE & ASSOCIATES 409 BROAD STREET PITTSBURGH, PA 15143			PASS, NATALIE	
			ART UNIT	PAPER NUMBER
			3626	

DATE MAILED: 03/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

DETAILED ACTION

Notice to Applicant

1. This communication is in response to the response filed 29 December 2005. Claims 1, 12-13, 24-25, 36-38 have been amended. Grounds of rejection for claims 1-38 are presented in the instant application as set forth in detail below.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Newly amended claims 1, 12-13, 24-25, 36-38 and claims 2-11, 14-23, 26-35 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

(A) Independent claims 1, 12-13, 24-25, 36-38 recite limitations that are new matter, and are therefore rejected. The added material which is not supported by the original disclosure is as follows:

- " wherein said one suggested menu is associated with at least one predetermined diet" as disclosed in claims 1, 12-13, 24-25, 36-38 at lines 5-6, 6-7, 8, 8, 5, 6-7, 6-7, 7-8, respectively.

35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. "New matter" constitutes any material which meets the following criteria:

a) It is added to the disclosure (either the specification, the claims, or the drawings) after the filing date of the application, and

b) It contains new information which is neither included nor implied in the original version of the disclosure. This includes the addition of physical properties, new uses, etc.

In particular, the Examiner was unable able to find any support for this newly added language within the specification as originally filed on 14 March 2001. Applicant is respectfully requested to clarify the above issues and to specifically point out support for the newly added limitations in the originally filed specification and claims.

(B) Claims 2-11, 14-23, 26-35 incorporate the features of independent claims 1, 13, and 25, through dependency, and are also rejected.

Applicant is required to cancel the new matter in the reply to this Office Action.

4. If Applicant continues to prosecute the application, revision of the specification and claims to present the application in proper form is required. While an application can, be amended to make it clearly understandable, no subject matter can be added that was not disclosed in the application as originally filed on 14 March 2001.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

NOTE: The following rejections assume that the subject matter added in the 29 December 2005 amendment are NOT new matter, and are provided hereinbelow for Applicant's consideration, on the condition that Applicant properly traverses the new matter objections and rejections made in sections 3 and 4 above in the next communication sent in response to the present Office Action.

6. Claims 1-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kolawa et al., U.S. Patent Number 6, 370, 513 in view of Froseth et al., U.S. Patent Application Publication Number 2002/0004749 for substantially the same reasons given in the previous Office Action (paper number 06142005). Further reasons appear hereinbelow.

(A) Claims 1, 12-13, 24-25, 36-38 have been amended to recite "wherein said one suggested menu is associated with at least one predetermined diet" in lines 5-6, 6-7, 8, 8, 5, 6-7, 6-7, and 7-8, respectively.

As per these new limitations, Kolawa and Froseth teach a system, method, and program storage device as analyzed and discussed in the previous Office Action (paper number 06142005)

wherein said one suggested menu is associated with at least one predetermined diet (Froseth; Figure 12A, Figure 12B, paragraphs [0110], [0175], [0179], [0191]-[0193], [0240]).

The remainder of claims 1, 12-13, 24-25, 36-38 is rejected for the same reasons given in the prior Office Action (paper number 06142005, section 3, pages 2-8), and incorporated herein.

The motivations for combining the respective teachings of Kolawa and Froseth are as given in the rejection of claim 1 in the prior Office Action (paper number 06142005) and incorporated herein.

(B) Claims 2-11, 14-23, and 26-35 have not been amended and are rejected for the same reasons given in the previous Office Action (paper number 06142005, section 3, pages 3-8), and incorporated herein.

Response to Arguments

7. Applicant's arguments filed 29 December 2005 have been fully considered but they are not persuasive. Applicant's arguments will be addressed hereinbelow in the order in which they appear in the response filed 29 December 2005.

(A) At pages 13-14 of the 29 December 2005 response, Applicant argues that the limitations of claims 1-38 are not taught or suggested by the applied references. In response, all of the limitations which Applicant disputes are missing in the applied references, including the newly added limitations of claims 1, 12-13, 24-25, 36-38, have been fully addressed by the Examiner as either being fully disclosed or obvious in view of the combined teachings of

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Kolawa and Froseth, based on the logic and sound scientific reasoning of one ordinarily skilled in the art at the time of the invention, as detailed in the 35 USC § 103 rejections given in the preceding sections of the present Office Action and in the prior Office Action (paper number 06142005), and incorporated herein. In particular, Examiner notes that “wherein said one suggested menu is associated with at least one predetermined diet” is taught by the applied references. In particular, please note (Froseth; Figure 12A, Figure 12B, paragraphs [0110], [0175], [0179], [0191]-[0193], [0240]), as specifically applied in the rejections given above and incorporated herein. Please note that Examiner interprets Froseth’s teachings of “the consumer can be presented with key nutritional information and specific and customized food product suggestions. This nutritional information, together with the customized food product suggestions can be generated automatically or manually ... [...] ... Optionally, the consumer can order a customized food product without completing the interactive survey” (emphasis added) (Froseth; paragraph [0110]); and “[i]n other embodiments, the customized food selection, ordering and distribution website is essentially a one-stop health resource for consumers ... [...] ... including, but not limited to child and teen nutrition, colon cancer risk reduction, diabetes, dietary guidelines, digestive health, energy, heart health, men’s health, mental health issues (e.g., depression, including postpartum depression), and so forth. Other topics can also be covered, such as specialty diets as described herein (low sodium, Weight Watcher’s.RTM.), etc., further including ethnic and religious diets, e.g., Lenten fasting, Jewish kosher foods, Islamic food law, Halal, etc. ... [...] ... In one embodiment there are also menu suggestions” (Froseth; paragraph [0175]); and “the unique interactive system of the present invention results in a one-of-a-kind and highly personalized menu” (Froseth; paragraph [0240]) as teaching the argued limitation.

At page 13 of the 29 December 2005 response, Applicant analyzes the applied references separately and argues each of the references individually. In response to Applicant's piecemeal arguments analysis of the references, it has been held that one cannot show nonobviousness by attacking references individually where, as here, the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed Cir. 1986). In addition, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

In response to Applicant's argument at paragraph 1 on page 13 of the 29 December 2005 response that the Kolawa reference fails teach "suggesting a menu that meets predetermined nutritional criteria" or "to maintain diet types" or "associating the meals with specific or predetermined diets," the Examiner respectfully submits that, as detailed in the prior Office Action (paper number 06142005, section 3, pages 2-8), it was the other applied reference, Froseth, that was applied to teach "predetermined nutritional criteria" (Froseth; paragraph [0119] – [0120]); Examiner also submits that maintaining data types is not a claimed limitation, however the Kolawa reference was applied to teach the limitation, as recited in claim 5, of "master diet type database" (Kolawa; column 7, lines 15-17). Furthermore, Examiner notes that the Froseth reference additionally teaches maintaining diet types (see Froseth's teachings of

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“specialty diets as described herein (low sodium, Weight Watcher's.RTM.), etc., further including ethnic and religious diets, e.g., Lenten fasting, Jewish kosher foods, Islamic food law, Halal, etc. ... [...]” (Froseth; Figure 9, paragraph [0175])) and Froseth’s teaching of diet types such as “no dairy products” and “a high protein, high fat, low carbohydrate diet” (Froseth; paragraph [0191])). As per the limitation “associating the meals with specific or predetermined diets,” this has previously been discussed above.

In response to Applicant's argument at paragraph 2 on page 13 of the 29 December 2005 response that the Froseth reference fails teach meal choices directed towards maintaining a specific type of diet or wherein said one suggested menu is associated with at least one predetermined diet, Examiner respectfully disagrees, as previously discussed above.

As per Applicant's argument at paragraph 2 on page 14 of the 29 December 2005 response that the there is no motivation to combine the references, Examiner assumes that Applicant is referring to the Kolawa and Froseth references, and not to the “Wang and Razin” references, which are undocumented in this application.

In response, the Examiner respectfully submits that obviousness is determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); *In re Hedges*, 783 F.2d 1038, 1039, 228 USPQ 685,686 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785,788 (Fed. Cir. 1984); and *In re Rinehart*, 531 F.2d 1048, 1052, 189 USPQ 143,147 (CCPA 1976).

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Using this standard, the Examiner respectfully submits that the burden of presenting a *prima facie* case of obviousness has at least been satisfied, since evidence of corresponding claim elements in the prior art has been presented and since Examiner has expressly articulated the combinations and the motivations for combinations that fairly suggest Applicant's claimed invention (see paper number 06142005). Note, for example, the motivations explicitly stated at lines 9-13 of page 3 of the previous Office Action (i.e., " ... with the motivation of catering to health concerns while meeting the diverse ...").

Furthermore, the Examiner recognizes that references cannot be arbitrarily altered or modified and that there must be some reason why one skilled in the art would be motivated to make the proposed modifications. And although the motivation or suggestion to make modifications must be articulated, it is respectfully submitted that there is no requirement that the motivation to make modifications must be expressly articulated within the references themselves. References are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures, *In re Bozek*, 163 USPQ 545 (CCPA 1969).

The Examiner is concerned that the Applicant apparently ignores the mandate of the numerous court decisions supporting the position given above. The issue of obviousness is not determined by what the references expressly state but by what they would reasonably suggest to one of ordinary skill in the art, as supported by decisions in *In re Delisle* 406 Fed 1326, 160 USPQ 806; *In re Kell, Terry and Davies* 208 USPQ 871; and *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ 2d 1596, 1598 (Fed. Cir. 1988) (citing *In re Lalu*, 747 F.2d 703, 705, 223 USPQ 1257, 1258 (Fed. Cir. 1988)). Further, it was determined in *In re Lamberti et al* 192 USPQ 278 (CCPA) that:

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- (i) obvious does not require absolute predictability;
- (ii) non-preferred embodiments of prior art must also be considered; and
- (iii) the question is not express teaching of references but what they would suggest.

According to *In re Jacoby*, 135 USPQ 317 (CCPA 1962), the skilled artisan is presumed to know something more about the art than only what is disclosed in the applied references. In *In re Bode*, 193 USPQ 12 (CCPA 1977), every reference relies to some extent on knowledge of persons skilled in the art to complement that which is disclosed therein. In *In re Conrad* 169 USPQ 170 (CCPA), obviousness is not based on express suggestion, but what references taken collectively would suggest.

In the instant case, the Examiner respectfully notes that each and every motivation to combine the applied references is accompanied by select portions of the respective reference which specifically support that particular motivation. As such, it is NOT seen that the Examiner's combination of references is unsupported by the applied prior art of record. Rather, it is respectfully submitted that explanation based on the logic and scientific reasoning of one ordinarily skilled in the art at the time of the invention that support a holding of obviousness has been adequately provided by the motivations and reasons indicated by the Examiner, *Ex parte Levengood* 28 USPQ 2d 1300 (Bd. Pat. App. & Inter., 4/22/93).

As such, it is respectfully submitted that Applicant appears to view the applied references separately and in a vacuum, without considering the knowledge of average skill in the art, and further fails to appreciate the breadth of the claim language that is presently recited.

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Conclusion

8. **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

9. **Any response to this final action should be mailed to:**

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Commissioner of Patents and Trademarks
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or faxed to: (571) 273-8300.

For formal communications, please mark
"EXPEDITED PROCEDURE".

For informal or draft communications, please label
"PROPOSED" or "DRAFT" on the front page of the
communication and do NOT sign the communication.

After Final communications should be labeled "Box AF."

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Natalie A. Pass whose telephone number is (571) 272-6774. The examiner can normally be reached on Monday through Thursday from 9:00 AM to 6:30 PM. The examiner can also be reached on alternate Fridays.

11. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas, can be reached at (571) 272-6776. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (571) 272-3600. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

12. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Natalie A. Pass

February 28, 2006



JOSEPH THOMAS
SUPERVISORY PATENT EXAMINER